

REMARKS

Claims 1, 2, 5, 6, 8-36 and 43-51 are pending in this application. By this Amendment, claim 1 is amended. The amendments introduce no new matter. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown Applicants' representative by Examiner Garcia during the August 21, 2006 telephone interview. Applicants' separate record of a summary of the substance of the personal interview is contained in the following remarks.

The Office Action, in paragraph 16, indicates that claim 49 recites allowable subject matter. Specifically, the Office Action indicates that claim 49 would be allowable if rewritten in independent form to include all the features of the base claim and any intervening claims. Applicants appreciate this indication of allowability of the subject matter of claim 49 but respectfully submit that at least claim 43, from which claim 49 depends, is allowable for at least the reasons indicated below.

The Office Action, in paragraphs 1-4, objects to claims 8, 9, 11 and 13 indicating that a feature recited in those claims lacks sufficient antecedent basis. Applicants amend claim 1 to provide antecedent basis for the enumerated feature. Withdrawal of the objection to claims 8, 9, 11 and 13 is respectfully requested.

The Office Action, in paragraph 6, rejects claims 1, 2, 6, 43-45 and 51 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,332,321 to Beauchamp et al. (hereinafter "Beauchamp"). The Office Action, in paragraphs 8-15, rejects claims 5, 8-20, 24-36, 46-48 and 50 under 35 U.S.C. §103(a) as being unpatentable over Beauchamp, taken alone or varyingly in view of one or more of U.S. Patent Nos. 4,566,345 to Erickson et al. (hereinafter "Erickson"), 6,305,786 to Plotkin et al. (hereinafter "Plotkin"), or 6,343,848 to Berg et al. (hereinafter "Berg"), or U.S. Patent Application Publication No. US/2005/0109766

to Miller et al. (hereinafter "Miller"), or JP-A-06-024097 to Kazuhiko. These rejections are respectfully traversed.

The Office Action, in paragraph 6, alleges that Beauchamp can reasonably be considered to teach combinations of features positively recited in at least independent claims 1 and 43. Specifically, the Office Action indicates that Beauchamp teaches a "thermally-conductive fluid ejector carriage/10/," with reference to Fig. 1 and col. 2, lines 29-30. This assertion in the Office Action is incorrect. Beauchamp teaches a "conventional carriage 10 useful in a large scale computer driven plotter." The carriage 10 is referred to in a number of instances throughout Beauchamp as being of plastic. Further, the bushings, i.e., "a pair of plastic front bushings 80, 82," alleged by the Office Action to correspond to the at least one thermally-conductive interface structure recited in the pending claims are also described as being of plastic. Plastic, as is employed in the carriage and/or bushings of Beauchamp, is not inherently thermally-conductive as is implied by, and/or stated in, the Office Action.

MPEP §2112 states that the Patent Office must provide rationale or evidence tending to show inherency when a basis of inherency is asserted. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1990), MPEP §2112 states, "[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Additionally, *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. Inter. 1990), §2112 quotes for the standard "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis in original). Plastics are not inherently thermally-conductive and no showing of such alleged inherency that would meet the above-cited standard is provided in the Office Action.

For at least this reason, Beauchamp cannot reasonably be considered to teach, or even to have suggested, the combinations of all of the features positively recited in independent claims 1 and 43.

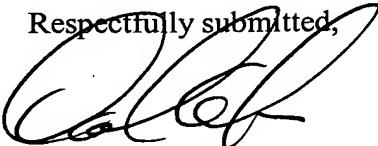
Applicants' representative presented this argument to Examiner Garcia during the August 21 telephone interview. The Examiner indicated that he understood Applicants' argument, and further indicated that Applicants' representative's argument seemed persuasive regarding plastic not being thermally conductive.

For at least the above reason, Beauchamp, even in combination with any of the other varyingly applied prior art references, cannot reasonably be considered to teach, or even to have suggested, the combinations of all the features positively recited in at least independent claims 1 and 43. Further, claim 2, 5, 6, 8-36, 44-48, 50 and 51 are also neither taught, nor would have they been suggested, by any combination of the applied prior art references for at least the respective dependence of these claims directly or indirectly on allowable independent claims, as well as for the separately patentable subject matter that each of these claims recites. It is important to note in this regard that none of the other applied prior art references is applied in such a manner to overcome the above-identified shortfall in the application of Beauchamp to the subject matter of independent claims 1 and 43.

Accordingly, reconsideration and withdrawal of the rejections of claims 1, 2, 5, 6, 8-36, 43-48, 50 and 51 under 35 U.S.C. §102(b) as being anticipated by Beauchamp, or under 35 U.S.C. §103(a) as being unpatentable over Beauchamp, alone or in combination with any of the other varyingly applied prior art references, are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2, 5, 6, 8-36, 43-48, 50 and 51, in addition to the indicated allowable subject matter of claim 49, are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,


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